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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,073	01/03/2001	Alan James Meier	PIP5740	4730

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EXAMINER

BARNES, CRYSTAL J

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 07/28/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,073

Applicant(s)

MEIER ET AL.

Examiner

Crystal J. Barnes

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 1 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is an initial Office Action upon examination of the above-identified application on the merits. Claims 1-22 are pending in this application.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The drawings are objected to because the shaded boxes in figures 1-4 do not permit clean copying and/or printing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: the term "center" on page 5 line 7 is misspelled; "that" on page 8 line 13 is incorrectly

capitalized; the abbreviation "CLI" (first occurrence on page 10 line 26) is unclear; the term "dialing" (first occurrence on page 11 line 16) is misspelled; the term "Onsend" on page 12 line 20 is unclear. Appropriate correction is required.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Messaging Delivery System.

Claim Objections

7. Claim 1 is objected to because of the following informalities: the term "holders" in line 5 of the claim should be "holder's". Appropriate correction is required.

8. Claim 18 is objected to because of the following informalities: the term "center" in line 1 of the claim is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Regarding claim 18, the term "e.g." renders the claim indefinite because it is unclear whether the limitation following the term is part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 2121

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,987,508 to Agraharam et al.

As per claim 1, the Agraharam et al. reference discloses a database server (see column 3 lines 56-59, "translation server 110") containing a database ("database 117") made up of a plurality of records, each record in the database ("database 117") defining at least an account holder (see column 4 lines 57-66, "registered user") and an email address (see column 4 lines 47-49, "e-mail address"), wherein the email address ("e-mail address") contains at least (in whole or in part) the account holder's telephone number (see column 5 lines 30-37, "telephone number") and the account holders name (see column 5 lines 24-30, "alphanumeric string"), and wherein each record follows a predetermined structure (see column 3 lines 39-50, "registration process") to facilitate use of that email address ("e-mail address") by another person ("sender").

As per claim 2, the Agraharam et al. reference discloses each record contains instructions (see column 3 lines 56-59, "Sendmail Daemon program") concerning the forwarding of an email (see column 3 lines 59-66, "forwards the

received e-mail message") received at that defined email address, to another email address ("recipient's actual e-mail address") designated by the account holder ("registered user").

As per claim 3, the Agraharam et al. reference discloses the database ("database 117") contains a plurality of records (see column 4 lines 34-39, "record"), preferably more than one per telephone number (see column 4 lines 2-8, "telephone number") from a telephone directory ("Directory Assistance"), wherein each email address (see column 5 lines 26-30, "alias telephone number e-mail address") is made up of the account holder's chosen telephone number ("telephone number alias name") and (in whole or in part) the account holder's given name ("alphanumeric string").

As per claim 4, the Agraharam et al. reference discloses software for delivering emails to a subscriber, wherein the software (see column 3 lines 56-59, "Sendmail Daemon program") contains or controls a database ("database 117") made up of a plurality of records (see column 4 lines 34-39, "record") corresponding to the entries (see column 4 lines 2-8, "telephone number") in a telephone directory ("Directory Assistance"), each record defining an account holder (see column 4 lines 57-66, "registered user") and an email address (see column 4 lines 47-49, "e-

mail address"), the email address ("e-mail address") containing at least (in whole or in part) the account holder's telephone number (see column 5 lines 30-37, "telephone number") and (in whole or in part) the account holder's name (see column 5 lines 24-30, "alphanumeric string"), wherein each record follows a predetermined structure (see column 3 lines 39-50, "registration process") to facilitate use of that email address ("e-mail address") by another person ("sender").

As per claim 5, the Agraharam et al. reference discloses each record contains instructions (see column 3 lines 56-59, "Sendmail Daemon program") concerning the forwarding of an email (see column 3 lines 59-66, "forwards the received e-mail message") received at that defined email address, to another email address ("recipient's actual e-mail address") designated by the account holder ("registered user").

As per claim 6, the Agraharam et al. reference discloses the database ("database 117") contains a plurality of records (see column 4 lines 34-39, "record"), preferably more than one per telephone number (see column 4 lines 2-8, "telephone number") from a telephone directory ("Directory Assistance"), wherein each email address (see column 5 lines 26-30, "alias telephone number e-mail

address") is made up of the account holder's chosen telephone number ("telephone number alias name") and (in whole or in part) the account holder's given name ("alphanumeric string").

As per claim 7, the Agraharam et al. reference discloses a method for delivering messages by email to a recipient, wherein an ISP (see column 2 lines 44-47, "ISP") allocates to each person within a defined group (see column 4 lines 45-47, "user or group of users"), an email address prefix ("recipient's telephone #") and defined ISP suffix ("domain_name"), the email address prefix ("recipient's telephone #") being made up of a unique alphanumeric identification code (see column 5 lines 26-30, "telephone number alias name"), each of which codes incorporates a predetermined combination of a telephone number ("telephone number"), and an alphabetic component ("alphanumeric string"), allowing users (see column 6 lines 6-8, "subscribing user") of the system to address an email (e-mail message) to a recipient (see column 4 lines 57-66, "registered user") by entering the unique alphanumeric identification code ("telephone number alias name") with that ISP suffix ("domain_name"), transmitting the desired email message (e-mail message) to the ISP ("ISP"), the ISP ("ISP") then redirecting the email message (e-mail message) to the recipient ("recipient") in a manner determined by the

recipient ("recipient's actual e-mail address") (when registered with the ISP ("registered user")).

As per claim 8, the Agraharam et al. reference discloses if having received an email (see column 4 lines 42-44, "e-mail message") for a particular recipient (see column 4 lines 52-54, "intended recipient"), the ISP ("ISP") determines that that recipient has not yet registered ("translation was not successful") with the ISP ("ISP") (even though the sender ("user sending") knows the recipient's pre-allocated email address ("recipient's telephone #@domain_name")), the ISP ("ISP") can communicate with that recipient by telephone (see column 52-54, "outbound voice-call"), or mail or some other medium to encourage the recipient to register (see column 4 lines 55-57, "invited to register") in order to receive the email message ("e-mail message").

As per claim 9, the Agraharam et al. reference discloses the group is made up of all (or substantially all) of the persons (see column 4 lines 2-8, "Lightweight Directory Access Protocol") listed in a telephone directory (see column 6 lines 6-22, "directory assistance").

As per claim 10, the Agraharam et al. reference discloses the group is made up of all (or substantially all) of the persons (see column 4 lines 2-8, "Lightweight

Directory Access Protocol") listed in all of the telephone directories ("directory assistance") in this country (see column 5 lines 15-23, "United States").

As per claim 11, the Agraharam et al. reference discloses the group is made up of all (or substantially all) of the companies or businesses (see column 4 lines 2-8, "Lightweight Directory Access Protocol") listed in a telephone directory (see column 6 lines 6-22, "directory assistance").

As per claim 12, the Agraharam et al. reference discloses a database (see column 3 lines 56-59, "database 117") for use in routing messages (see column 3 lines 59-66, "forwards the received e-mail message") to account holders (see column 4 lines 57-66, "registered user"), the database ("database 117") containing a plurality of records corresponding to one or more telephone directories (see column 6 lines 6-22, "directory assistance"), each record in the database ("database 117") defining at least an account holder (see column 4 lines 57-66, "registered user") and an email address (see column 4 lines 47-49, "e-mail address"), the email address ("e-mail address") containing at least (in whole or in part) the account holder's telephone number (see column 5 lines 30-37, "telephone number") and (in whole or in part) the account holder's name (see column 5 lines 24-30, "alphanumeric string"), wherein each record follows a predetermined

structure (see column 3 lines 39-50, "registration process") to facilitate use of that email address ("e-mail address") by another person ("sender").

As per claim 13, the Agraharam et al. reference discloses each record contains instructions (see column 3 lines 56-59, "Sendmail Daemon program") concerning the forwarding of an email (see column 3 lines 59-66, "forwards the received e-mail message") received at that defined email address, to another email address ("recipient's actual e-mail address") designated by the account holder ("registered user").

As per claim 14, the Agraharam et al. reference discloses the database ("database 117") contains a plurality of records (see column 4 lines 34-39, "record"), preferably more than one per telephone number (see column 4 lines 2-8, "telephone number") from a telephone directory ("Directory Assistance"), wherein each email address (see column 5 lines 26-30, "alias telephone number e-mail address") is made up of the account holder's chosen telephone number ("telephone number alias name") and (in whole or in part) the account holder's given name ("alphanumeric string").

As per claim 15, the Agraharam et al. reference discloses the database ("database 117") contains records corresponding to all or substantially all of the

people persons (see column 4 lines 2-8, "Lightweight Directory Access Protocol") listed in the telephone directories ("directory assistance") in any given population in the USA (see column 5 lines 15-23, "United States").

As per claim 16, the Agraharam et al. reference discloses the "email address" (see column 6 lines 35-39, "actual e-mail address") is used as a "media independent address", the database ("database 117") storing address information (see column 6 lines 39-42, "user's address") for each account holder ("registered users") including one or more of the following: postal address ("snail-mail"), DX address, courier address, and fax number.

As per claim 18, the Agraharam et al. reference discloses a messaging system including a message storage or redirection center which makes use of an identification system for individuals, which identification system involves allocation to each individual in a group (see column 4 lines 45-47, "user or group of users"), a unique alphanumeric identification code (see column 5 lines 26-30, "telephone number alias name"), each of which codes incorporates a predetermined combination of: an individual's telephone country number prefix (see column 5 lines 8-14, "country code"); an individual's telephone area number (see column 5 lines 30-37, "telephone number"); an alphabetic or alphanumeric representation

("alphanumeric string") of at least part of an individual's name ("particular individual"); and at least part of an individual's telephone number ("telephone number").

As per claim 19, the Agraharam et al. reference discloses the unique alphanumeric identification code is made up of a string in the sequence: a-b-c-d, wherein "a" represents the individual's international telephone country number prefix (see column 5 lines 12-15, "country code"), "b" represents the individual's telephone area number (see column 5 lines 30-37, "201"), "c" represents the individual's telephone number (see column 5 lines 30-37, "5558765") and "d" represents the first three letters of the individual's given name (see column 5 lines 26-30, "alphanumeric string"), and the first letter of the individual's family name ("alphanumeric string").

As per claim 20, the Agraharam et al. reference discloses apparatus for delivering emails including: a database server (see column 3 lines 56-59, "translation server 110") containing a database ("database 117") made up of a plurality of records, which database ("database 117") relates to a defined public directory (see column 4 lines 2-8, "Lightweight Directory Access Protocol"), each record in the database ("database 117") defining at least an account holder (see

column 4 lines 57-66, "registered user") and an email address (see column 4 lines 47-49, "e-mail address"), the email address ("e-mail address") containing at least (in whole or in part) data from the account holder's record in the public directory (see column 5 lines 30-37, "telephone number") and (in whole or in part) the account holder's name (see column 5 lines 24-30, "alphanumeric string"), wherein each record follows a predetermined structure (see column 3 lines 39-50, "registration process") to facilitate use of that email address ("e-mail address") by another person ("sender").

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,987,508 to Agraharam et al. ('508 Agraharam et al.) in view of USPN 6,023,700 to Owens et al.

As per claim 17, the Agraharam et al. reference does not expressly disclose the database includes the account holder's wishes as to the preferred means of delivery of the messages, and any filter that the account holder wishes to be placed on incoming messages.

The Owens et al. reference discloses

(see column 3 lines 5-10, "The service provider or access service ... delivery of voice mail, e-mail, and fax messages knows the receiver's preferences ... so all messages may be delivered to the receiver in accordance with his or her preferences.")

(see column 3 lines 49-65, "... the connection software allows a user to define rules or filter and forward instructions for managing incoming and outgoing messages. ... a message receiver may indicate a preferred communication medium ... messages initiated via the telephone ... forwarded to an e-mail mailbox for later viewing. ... messages initiated via a computer/modem ... forwarded to a voice mailbox for later retrieval.")

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the alias telephone number e-mail system taught by the '508 Agraharam et al. reference with the integrated e-mail, voice

mail and fax mail messaging system taught by the Owens et al. reference to enable a subscriber to retrieve e-mail, voice mail, and fax mail messages by accessing only the e-mail system.

One of ordinary skill in the art would have been motivated to enable a subscriber to retrieve e-mail, voice mail, and fax mail messages by accessing only the e-mail system to save a subscriber time by eliminating the need to separately retrieve e-mail messages left on an e-mail system, voice mail messages left on a voice-mail system, and fax mail messages left on a fax machine.

16. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,987,508 to Agraharam et al. ('508 Agraharam et al.) in view of USPN 6,085,231 to Agraharam et al. ('231 Agraharam et al.)

As per claim 21, the '508 Agraharam et al. reference does not expressly disclose the email may comprise one or more of text, image data, voice or sound data, SMS message, WAP message.

The '231 Agraharam et al. reference discloses

(see column 2 lines 52-67, "... voice-mail system 106 ... message converter 107 ... stored audio message to a .WAV file ... stored audio message to text ... The

converted audio message, as either a .WAV file or a text file, is appended to an e-mail message ...")

(see column 3 lines 3-5, "An e-mail message containing the stored text file or the .WAV file is then sent over the Internet 109 to a translation server 110 ...")

(see column 4 lines 13-17, "... the e-mail message containing the text or .WAV file is forwarded to the subscriber's actual e-mail address. ... e-mail server and either reads or listens to it ...")

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the alias telephone number e-mail system taught by the '508 Agraharam et al. reference with both voice-mail messages and e-mail messages delivery taught by the '231 Agraharam et al. reference to enable a subscriber to retrieve both voice-mail messages and e-mail messages by accessing only the e-mail system.

One of ordinary skill in the art would have been motivated to enable a subscriber to retrieve both voice-mail messages and e-mail messages by accessing only the e-mail system to save a subscriber time by eliminating the need to separately retrieve voice-mail messages left on a voice-mail system and e-mail messages left on an e-mail system.

As per claim 22, the rejection of claim 21 is incorporated and further claim 22 contains limitations recited in claim 21; therefore claim 22 is rejected under the same rationale as claim 21.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to message delivery systems in general:

USPN 6,014,711 to Brown

USPN 6,292,799 B1 to Peek et al.

USPN 6,333,973 B1 to Smith et al.

USPN 6,356,937 B1 to Montville et al.

USPN 6,363,140 B1 to Pinard

USPN 6,400,810 B1 to Skladman et al.

USPN 6,498,797 B1 to Anerousis et al.

US Pub. No. 2002/0176117 A1 to RANDALLI et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal J. Barnes whose telephone number is 703.306.5448. The examiner can normally be reached on Monday-Friday alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703.308.3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cjb
8 June 2004


Anthony Knight
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